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EXAMINER

MATTER, KRISTEN CLARETTE

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/522,721
Filing Date: March 11, 2005
Appellant(s): JORDAN, CLIFFORD L.

Robert E. Bushnell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/23/2010 appealing from the Office action mailed 10/26/2009.

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(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 54-65 and 71-75.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

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(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,820,616	JORDAN	11-2004
5,979,444	SHERROD	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 59-64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-21, 23, 24, 28, and 39 of U.S. Patent No.

6,820,616 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 59 has everything as recited in the patented claim 21 including a controller. The only difference is the recitation of a control panel with a “mode selection switch.” However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a control panel to US’616’s controller so that the user can adjust the settings via the switches. Note that the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21). It is considered that the controller is coupled to all the units and the common gas system for providing the controlling function. The limitation of a control panel is also found in the patented claim 39. In addition, having a switch in a control panel is a well-known feature for controlling a system. The limitation of a switch is also found in the patented claim 39. Thus, any infringement over the patent would also infringe on the instant claims.

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The limitations of claim 60 can be found in patented claim 20 (again it would have been obvious to include a control panel with a mode selection switch for the device with four testing units instead of three). The limitations of claim 61 can be found in patented claim 21. The limitations of claim 62 can be found in patented claim 23. The limitations of claim 63 can be found in patented claim 24. The limitations of claim 64 can be found in patented claim 28.

Claims 54-58 and 71-75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7, 9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 in view of Sherrod (US 5,979,444 A). Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 54 has everything as recited in the patented claim 1 except the recitation of a “regulator enable valve.” However, regulator enable valves are well known and commonly used in the art. For example, Sherrod discloses a breathing apparatus with a regulator enable valve (22) coupled to a pressure regulator (90) to control the pressure of air flowing through the regulator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a regulator enable valve as taught by Sherrod and is well known in the art to US’616’s system so that the pressure of air flowing through the regulator can be accurately controlled to provide breathable air at a safe pressure to a user.

The limitations of claim 55 can be found in patented claim 4. The limitations of claim 56 can be found in patented claim 7. The limitations of claim 57 can be found in patented claim 9. The limitations of claim 58 can be found in patented claim 17. The limitations of claim 71 can be found in patented claims 26 and 27.

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The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US'616's controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.

(10) Response to Argument

A. Any infringement over US 6,820,616 would also infringe on the instant claims 59-64.

As discussed in the previous rejection, all of the limitations of the instant claims 59-64 can be found in US 6,820,616 except for the control panel with a mode select switch. However, control panels and switches are obvious components in any controllable electrical system to allow operation of the device. As discussed in the final rejection of 10/26/2009, "panels" are well known and commonly used to hide/insulate electrical components from a user and the term "mode select switch" provides no definite structural limitation other than being a switch capable of controlling flow of air through the compressors, which is also well known in the art. The patented claims include a controller that is coupled to and controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21) with switches. US 6,820,616 claims a control panel and switches for controlling the device in claim 39. Although not claimed in combination with all of the other features of patented claim 21 required to read on instant claim 59, examiner merely points out that this supports her conclusion of obviousness since it is also obvious to combine various well

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known components claimed and/or disclosed in the prior art absent a teaching otherwise. Similar arguments exist for the remaining instant claims as pointed out in the previous rejection. Since the modification of patented claim 21 to include a control panel and a mode select switch is obvious to one of ordinary skill in the art, any infringement over the patent would also infringe on the instant claims.

Appellant argues on page 33 of the appeal brief that the rejection is erroneous because of the statement “the only difference” used in rejection when describing the patent and instant claims. This argument is not convincing because the rejection is an obvious-type double patenting, meaning that the differences in the subject matter of the claims are obvious, not that the claims are identical. Examiner has described in detail how and why any modification to the patent is obvious to one of ordinary skill in the art. Likewise, appellant argues that the term “only difference” makes the rejection erroneous on page 48 of the appeal brief. However, examiner was referring merely to any structure found in the instant claims that the patented claims lack. Any additional structure found in the patent (such as multiple sensors and valves) only further narrows the patent and has no effect on the double patenting rejection as long as the patent has at least the claimed structure of the instant claims or the instant claim involves an obvious modification.

Appellant also states that there are claimed relationships between the flow of air and control panel which make a conclusion of obviousness improper. However, these concerns were also addressed in the rejection and final action of 10/26/2009. The “relationships” that appellant refers to are simply that the control panel is “coupled” to the various components of the system and that the mode select switch controls flow of air. However, this is merely describing what is

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at least obvious if not inherent when using a controller and switches to control operation of a gas flow system. For example, in the patent, the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21). Clearly, the controller must be “coupled” to all of the units/compressors and the common gas system for providing the claimed controlling function. Similarly, it would have at least been obvious to one of ordinary skill in the art at the time the invention was made to have designed the switches to control the flow of air through the compressors because this how the tests are performed in the patented claims as well as the instant claims (i.e., what else would the switches be controlling in an air flow system if not the flow of air?). Additionally, it is obvious that a system with multiple testing units and a controller will need a means of switching between the various tests and controlling the individual components of the system.

B. Any infringement over US 6,820,616 in view of US 5,979,444 would also infringe on the instant claims 54-58 and 71-75.

Similar to the discussion regarding claims 59-63, US 6,820,616 has all of the structure required to read on instant claim 54 except the recitation of a “regulator enable valve.” However, as discussed in the previous rejection, regulator enable valves are well known and commonly used in the art as taught by Sherrod, who discloses a breathing apparatus with a regulator enable valve (22) coupled to a pressure regulator (90) to control the pressure of air flowing through the regulator. Since it is common practice and well known to have regulator valves when supplying air from a pressurized source to human lungs in order to maintain air pressure at a safe level for breathing, such a modification to the US 6,820,616 patent is considered obvious to one of

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ordinary skill in the art and does not patentably distinguish the instant invention over the prior art. Similar arguments exist for the remaining claims as discussed in the previous rejection.

Appellant argues that the distinctiveness between the instant claims and the patented claims makes the rejection improper. However, as discussed in the preceding section, the rejection is an obvious-type double patenting rejection, meaning that the differences in the subject matter of the claims are obvious, not that the claims are identical. Examiner has described in detail how and why any modification to the patent is obvious to one of ordinary skill in the art.

Appellant also states that there are claimed relationships between the flow of air and control panel which make a conclusion of obviousness improper and that examiner fails to consider the claimed subject matter as a whole. However, these concerns were addressed in the rejection and final action of 10/26/2009. The “relationships” that appellant refers to are simply that the control panel is “coupled” to the various components of the system and that the mode select switch controls flow of air. However, this is merely describing what is at least obvious if not inherent when using a controller and switches to control operation of a gas flow system. For example, in the patent, the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21). Clearly, the controller must be “coupled” to all of the units/compressors and the common gas system for providing the claimed controlling function. Similarly, it would have at least been obvious to one of ordinary skill in the art at the time the invention was made to have designed the switches to control the flow of air through the compressors because this how the tests are performed in the patented claims as well as the instant claims (i.e., what else would the switches be “controlling”

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in an air flow system if not the flow of air?). Additionally, it is obvious that a system with multiple testing units and a controller will need a means of switching between the various tests and controlling the individual components of the system.

C. This application is not a divisional of US 6,820,616 since priority was not properly claimed.

Appellant has numerous arguments that US 6,820,616 cannot be used in a double patenting rejection because the instant case is a divisional child case of US 6,820,616 and a restriction requirement was made in US 6,820,616. In fact, appellant states on page 40 of the appeal brief that these facts are “undisputed”. This statement is simply false because as pointed out to appellants on numerous occasions, in order to make a claim for priority certain criteria must be met. Specifically, a reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if appellant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Furthermore, if the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application.

As discussed previously on the record, including the final action of 10/26/2009, there is no record of an application data sheet ("ADA") being submitted at the filing of the instant

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application, despite appellant's claims to the contrary. It is unclear where the ADA copied on page 41 of the appeal brief is located in the application record and as such, it cannot be accepted for purposes of establishing a priority benefit. Likewise, the original specification mentioned the parent case in the first sentence but the reference did not properly include the relationship of the applications as required by 37 CFR 1.78(a). Accordingly, an attempt to amend the specification to properly include the relationship on 3/27/2008 was made too late to comply with 37 CFR 1.78(a). Since no benefit was timely claimed in the required manner, the instant application is not considered a divisional of US 6,820,616.

Examiner points out that a benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. Here, a petition must be filed for the benefit claim to be considered.

On the other hand, if the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR

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1.17(t) are not required. Appellant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11. Unfortunately, the original filing receipt did not recognize the instant application as being related to US 6,820,616 so the petition is still needed since the examiner determined that the benefit claim was not proper.

Since the instant application is not a division of US 6,820,616, the patent is not prohibited from being used in the previous double patenting rejections under 35 USC § 121.

D. Even if this application is considered a divisional of US 6,820,616, the patent is not prohibited from being used in a double patenting rejection since the same invention is claimed in both.

Even if the instant case is considered to be a division of US 6,820,616, the patent is not prohibited from being used in double patenting rejections. Appellant argues that since there was a prior restriction requirement in US 6,820,616, the patent cannot ever be used in a double patenting rejection of a child divisional case. Examiner agrees that there was a restriction requirement made in US 6,820,616 that was not withdrawn during prosecution. The requirement was between a specific apparatus and a distinct method of using a specific apparatus. The specific apparatus was elected, examined, and allowed in US 6,820,616.

Appellant makes numerous statements involving the "style" of the claims and that the later divisional case need to be limited to a single one of the examiner's demarcated inventions to rely on the safe harbor of 35 USC § 121. What appellant fails to appreciate is that the SAME invention as the one elected, examined, and allowed in US 6,820,616 is being examined in the instant case. Appellant keeps referring to "subject matter" of the claims, but as discussed in

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sections A and B above, the "subject matter" of the patented claims in US 6,820,616 and the instant claims is in fact the same (i.e., the patented claims and the instant claims are not directed to distinct inventions at all, nor are they even directed to claims/subject matter that was non-elected in the parent case). Regardless of the style of the claims, any infringement over the patent would infringe on the instant claims because the required modifications to the patented claims are obvious. Appellant argues that the instant claims are drawn to the non-elected "method of operating a gas system" on pages 51 and 63 of the appeal brief, for example, but as seen by direct comparison of the instant claims and patented claims (as done in the double patenting rejection) appellant has missed the mark if this was the intention because this is simply not the case. Although claims in a later filed divisional case do not have to be drawn to a single one of the identified inventions from a parent case's restriction requirement (or contain identical language from non-elected claims of a parent case), the claims simply CANNOT be drawn to the same elected invention as in the parent case for the safe harbor of 35 USC § 121 to apply.

Also, appellant points to MPEP § 803.01 on page 62 of the appeal brief. However, this simply points out the public interest in not granted two patents for the same invention. Here, the restriction requirement in US 6,820,616 was properly made between two separate, distinct inventions. If appellant had actually claimed the non-elected separate, distinct invention (using any style of claim writing) in the instant case then there could be no proper double patenting rejection using US 6,820,616. However, appellant has claimed the same invention as elected in US 6,820,616 and therefore, the patent is not prohibited from being used in a double patenting rejection since two patents cannot be issued for the same invention.

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E. Summary

It is the examiner's position that there is an obvious-type double patenting issue involving the instant claims and US 6,820,616 (with or without US 5,979,444). If the Board agrees that the proposed modifications to the instant claims involving the control panel, mode select switch, and/or regulator valve is proper, then it must be determined whether 35 USC § 121 mandates prohibition of use of US 6,820,616 in a double patenting rejection. It is examiner's position that benefit was not properly claimed to US 6,820,616 and therefore, since the instant case is not considered a divisional of US 6,820,616, 35 USC § 121 does not prevent US 6,820,616 from being used in a double patenting rejection. On the other hand, even if the instant case is considered a divisional of US 6,820,616, since appellant has chosen to elect/pursue the same/identical invention in both cases, a double patenting rejection is in fact proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kristen C. Matter/

Examiner, Art Unit 3771

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